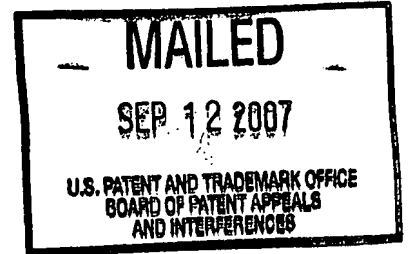


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RYOTA SUGIMOTO

Application 09/870,672



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 25, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter requiring attention prior to docketing is identified below:

An examination of the Image File Wrapper (IFW) reveals that an Order Returning Undocketed Appeal to Examiner (hereinafter, Order) was mailed on September 18, 2006 which requested that appellant be notified to

submit a substitute Appeal Brief which corrected the “Summary of claimed subject matter” and added the “Grounds of rejection to be reviewed on appeal.” A compliant Appeal Brief was filed on December 5, 2006.¹

An Examiner’s Answer was mailed on March 23, 2007. Section (9) Grounds of Rejection, appearing on page 3, reads as follows:

Claims 1, 4, 5, 9-13, 20, 22-23, 32-37, and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley (6,293,967) in view of Palmaz (WO99/23977). Please refer to paragraph numbered 2 of the office action mailed 09/07/2005.

Claims 14-19 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley (6,293,967) in view of Palmaz (WO99/23977) as applied to claim 1 above, and further in view of Alt et al. (5,788,979). Please refer to paragraph numbered 3 in the office action mailed 09/07/2005.

According to § 1207.02 of the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Rev. 3 (August 2005):

An examiner’s answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.

¹ The initial Appeal Brief filed October 18, 2006, after the September 18, 2006 Order, was deemed to be deficient. A Notice of Non-Compliant Appeal Brief was mailed on December 4, 2006.

The Examiner's Answer mailed March 23, 2007 is deficient because the examiner has not included an explanation for each ground of rejection.

Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to prepare a PTOL-90 which corrects the "Grounds of Rejection";
- and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: *Patrick J. Nolan*
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PJN:psb

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